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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/764,561	01/17/2001	Robert Wayne Glenn JR.	8386	6898

27752 7590 04/14/2003

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EXAMINER

SHEIKH, HUMERA N

ART UNIT	PAPER NUMBER
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1615

DATE MAILED: 04/14/2003

13

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/764,561

Applicant(s)

GLENN ET AL.

Examiner

Humera N. Sheikh

Art Unit

1615

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 January 2003 (paper no. 12).
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-42 is/are pending in the application.
- 4a) Of the above claim(s) 28-40 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-27, 41 and 42 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Status of the Application

Acknowledgement is made of the receipt of the request for extension of time (6 months) and the response to the Restriction requirement, both filed 01/16/03.

Applicant's election with traverse of Group I (claims 1-27, 41 & 42) in Paper No. 12 is acknowledged. The traversal is on the ground(s) that in the present case, "any prior art search set up for claim 1 would be coextensive with that for the dependent claims and claims directed to a kit containing a composition according to claim 1 or an emulsifiable concentrate because the novel compositions and kit, per se, vis-à-vis the art, involve the same matter." This is not found persuasive because the claims of Group I are capable of supporting a separate patent within the art as they are directed to a treatment composition whereas the claims of Group II are drawn to a compartmentalized kit and method of treating amino based substrates wherein the kit contains two separate compositions. The requirement is still deemed proper and is therefore made FINAL.

Claims 28-40 have been withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected subject matter, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 12.

The non-statutory Double Patenting rejections and the 35 USC 112 second paragraph rejections have been withdrawn.

Claims 1-27, 41 and 42 are pending. Claims 1-27, 41 and 42 remain rejected.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-27, 41 and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gough et al. (US Pat. No. 5,525,332) in view of Deppert et al. (US Pat. No. 5,087,733).

Gough teaches a polymer with a silicone functional group (polymer of the claimed "electrophilic reactive group") (see reference cols. 12-13). The polymer is used in cosmetic preparations (emulsions) for conditioning of the hair (see abstract and cols.

Art Unit: 1615

7-8). Solvents include volatile or non-volatile silicones and hydrocarbons (col. 8). Emulsifiers (anionic, nonionic, amphoteric, and/or zwitterionic) are used to stabilize the emulsified particles (col. 9). The compositions demonstrate enhanced deposition of the polymer by way of reaction if the functional group with the nucleophilic group is on the substrate.

Group is silent as to a nucleophilic reactive group of a thiol type reactive agent.

Deppert teaches such a reactive agent at Example IV. Such thiol reactive agents are used in conditioning of hair substrates. Due to their molecular structure, the molecules are capable of forming covalent bonds with the sulfhydryl radicals of the hair (see col. 9). Conventional additives including surfactants and emulsifying agents are included at col. 10.

Therefore it would have been obvious for one of ordinary skill in the art at the time the invention was made to use the teachings of *Deppert* within the teachings of *Gough* because both *Deppert* and *Gough* teach that similar effective conditioning results could be achieved and both teach that the claimed polymers are useful due to their chemical affinity to substrates including hair. The expected result would be an effective hair conditioning formulation for the treatment of hair.

Response to Arguments

The applicant's arguments filed 01/16/03 have been fully considered, but were not found to be persuasive.

The applicant argued, "Gough neither teaches or suggests a means to accomplish the present invention's low energy emulsification of a reactive agent in a non-aqueous system that is able to self or spontaneously emulsify upon dilution with water or a separate aqueous composition and that Gough teaches one or more surfactants, however, no mention is made as to the use of these surfactants or the specialized surfactants."

These arguments have been fully considered, but were not found to be persuasive. Gough teaches a polymer with a silicone functional group (polymer of the claimed "electrophilic reactive group"). The polymer is used in cosmetic preparations (emulsions) for conditioning of the hair. Emulsifiers (anionic, nonionic, amphoteric, and/or zwitterionic) are used to stabilize the emulsified particles (col. 9). Gough teaches the use of one or more surfactants in order to provide detergent action. The prior art teaches a similar formulation comprising similar ingredients for a related purpose. It is of no moment that the prior art recognize each and every property associated with a particular ingredient or component, merely that the prior art recognized the teaching of the component for a similar or related purpose, is sufficient.

The applicant also argued, "there is no motivation to combine the reference of Deppert with Gough."

This argument has been fully considered, but was not found to be persuasive. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is

Art Unit: 1615

some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, *Gough* teaches a polymer with a silicone functional group (polymer of the claimed "electrophilic reactive group"). The polymer is used in cosmetic preparations (emulsions) for conditioning of the hair. Solvents, which include volatile or non-volatile silicones and hydrocarbons are also taught. Emulsifiers (anionic, nonionic, amphoteric, and/or zwitterionic) are used to stabilize the emulsified particles. The compositions demonstrate enhanced deposition of the polymer by way of reaction if the functional group with the nucleophilic group is on the substrate. *Gough* is silent as to a nucleophilic reactive group of a thiol type reactive agent. *Deppert* teaches and was relied upon for the teaching of such a reactive agent as seen in Example IV. Such thiol reactive agents are used in conditioning of hair substrates. Due to their molecular structure, the molecules are capable of forming covalent bonds with the sulfhydryl radicals of the hair.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within

Art Unit: 1615

TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Humera N. Sheikh whose telephone number is (703) 308-4429. The examiner can normally be reached on Monday through Friday from 7:00A.M. to 4:30P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman Page, can be reached on (703) 308-2927. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

hns

April 09, 2003

THURMAN K. PAGE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600